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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,766	06/21/2006	Thomas Jaetsch	CH-8458/CHS03 1011	8750
34947	7590	05/18/2011		
LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112			EXAMINER BECKHARDT, LYNDSEY MARIE	
			ART UNIT	PAPER NUMBER
			1613	
			NOTIFICATION DATE	DELIVERY MODE
			05/18/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipmail@lanxess.com

Office Action Summary

Application No.

10/583,766

Applicant(s)

JAETSCH ET AL.

Examiner

LYNDSEY BECKHARDT

Art Unit

1613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10-19 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-2, 10-19 and 23-27 are currently pending. Claims 23-27 are currently under examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2010 has been entered.

Examiner's Note

Unless otherwise indicated, previous objection/rejections that have been rendered moot in view of the amendment will not be reiterated. The arguments in the 11/17/2010 response will be addressed to the extent they apply to current rejection(s).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

New Rejections:

New rejections are applied based on Applicant's cancellation of all previously examined claims and newly added claims 23-27.

Claim Rejections - 35 USC § 103

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0149080 (previously applied) in view of US 5,223,178.

Determining the scope and contents of the prior art.

Regarding claim 23, the '080 publication teaches an insecticidally active compound according to formula (I) metal salts thereof and/or acid addition compounds thereof (abstract); and a further fungicidally active compound (abstract).

The '080 publication does not teach a further fungicidally active compound chosen from the group which includes benzalkonium chloride (claim 23).

The '080 publication does not teach wherein the at least one quaternary ammonium compound is present in an amount ranging from 0.01 to 40% by weight based on the weight of the composition (claim 24).

Regarding claim 23, the '178 patent teaches a further fungicidally active compound chosen from the group which includes benzalkonium chloride (column 1, lines 50-55).

Regarding claim 24, the '178 patent teaches wherein the at least one quaternary ammonium compound is present in an amount ranging from 0.01 to 40% by weight based on the weight of the composition (column 3-4, Table 5; (1.6 ammonium/581.17 total)*100 = 0.275 %). In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re

Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

***Ascertaining the differences between the prior art and the claims at issue, and
Resolving the level of ordinary skill in the pertinent art.***

People of the ordinary skill in the art will be highly educated individuals such as medical doctors, scientists, or engineers possessing advanced degrees, including M.D.'s and Ph.D.'s. Thus, these people most likely will be knowledgeable and well-read in the relevant literature and have the practical experience in insecticidally and fungicidally active compositions. Therefore, the level of ordinary skill in this art is high.

"A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at ___, 82 USPQ2d at 1396.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use benzalkonium chloride taught by the '178 patent in the composition taught by the '080 publication because benzalkonium chloride is taught

to be a fungicidally active compound (column 1, lines 50-55) and the '080 publication teaches the composition comprising a fungicidally active material (abstract). One of ordinary skill in the art at the time the invention was made would have a reasonable expectation of success as the '178 patent teaches a wood protecting composition comprising the fungicidally active benzalkonium chloride (column 1, lines 50-55) and the '080 publication teaches the composition used for the protection of wood and wooden materials [0123].

The cited prior art meets the criteria set forth in both *Graham* and *KSR*, and the teachings of the cited prior art provide the requisite teachings and motivations with a clear, reasonable expectation of success. Thus, absent evidence to the contrary, the invention as a whole is *prima facie* obvious.

Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0149080 (previously applied) in view of US 6,416,789.

Determining the scope and contents of the prior art.

Regarding claims 25 and 27, the '080 publication teaches an insecticidally active compound according to formula (I) metal salts thereof and/or acid addition compounds thereof (abstract); and a further fungicidally active compound (abstract).

The '080 publication does not teach a further insecticidally active compound of said composition, at least one boron compound selected from the group consisting of a boric ester and borax (claim 25).

The '080 publication does not teach wherein the at least one boron compound is present in an amount ranging from 0.01 to 40% by weight based on the weight of the composition (claim 26).

The '080 publication does not teach as a further insecticidally active compound boric acid (claim 17).

Regarding claims 25 and 27, the '789 patent teaches a further insecticidally active compound of said composition, at least one boron compound selected from the group consisting of a boric ester and borax and boric acid (column 2, lines 53-61, column 4, lines 59-65, claim 14).

Regarding claim 26, the '789 patent teaches wherein the at least one boron compound is present in an amount ranging from 0.01 to 40% by weight based on the weight of the composition (column 5, lines 10-15). In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

***Ascertaining the differences between the prior art and the claims at issue, and
Resolving the level of ordinary skill in the pertinent art.***

People of the ordinary skill in the art will be highly educated individuals such as medical doctors, scientists, or engineers possessing advanced degrees, including M.D.'s and Ph.D.'s. Thus, these people most likely will be knowledgeable and well-read

in the relevant literature and have the practical experience in insecticidally and fungicidally active compositions. Therefore, the level of ordinary skill in this art is high.

"A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at ___, 82 USPQ2d at 1396.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use boric acid ester or borax taught by the '789 patent (column 2, lines 53-61, column 4, lines 59-65, claim 14) in the composition taught by the '080 publication because the boric acid ester and borax are taught to be a fungicidally active compound (claim 14) and the '080 publication teaches the composition comprising a fungicidally active material (abstract). One of ordinary skill in the art at the time the invention was made would have a reasonable expectation of success as the '789 patent teaches a wood protecting composition comprising the fungicidally active boric acid ester or borax (claim 1) and the '080 publication teaches the composition used for the protection of wood and wooden materials [0123]. One of ordinary skill in the art would have a reasonable expectation of success in using the boric acid ester or

borax compounds taught by the '789 patent in the composition taught by the '080 publication because the '080 publication the composition can contain traces of boron [0101].

The cited prior art meets the criteria set forth in both *Graham* and *KSR*, and the teachings of the cited prior art provide the requisite teachings and motivations with a clear, reasonable expectation of success. Thus, absent evidence to the contrary, the invention as a whole is *prima facie* obvious.

Response to Arguments:

Applicant argues newly added claim 27 relates to a synergistic combination of thiacloprid and boric acid. As indicated in the previously submitted Declaration, the combination of thiacloprid and boric acid yields an unexpected synergy, therefore the applied prior art does not render the claimed synergistic combination obvious.

In response, as discussed in the previous office action (dated 10/08/2010) the declaration provided 08/19/2010 provides evidence of synergy for a specific concentration of thiacloprid and boric acid. The instant claims are broadly directed to the combination of thiacloprid and boric acid, with no concentrations claimed. The presented unexpected results are not commensurate in scope with the instant claims.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNDSEY BECKHARDT whose telephone number is (571)270-7676. The examiner can normally be reached on Monday thru Thursday 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Kwon can be reached on (571) 272-0581. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYNDSEY BECKHARDT/
Examiner, Art Unit 1613

/Kevin K. Hill/
Primary Examiner, Art Unit 1633